

REMARKS

Claims 1-61 are pending in the present application.

Claims 22-30 have been withdrawn due to a restriction requirement.

Claims 10-21 have been objected to.

Claim 1-9 and Claims 31-61 have been rejected.

Claims 39 and 51 have been amended.

Please reconsider Claims 1-21 and Claims 31-61.

Election/Restriction

In Paragraph 1 on Page 2 of the September 3, 2004 Office Action, the Examiner made final the restriction requirement withdrawing Claims 22-30 from consideration. The Examiner cited two references that described devices that are used to clean plaque from the inside of a blood vessel. The Applicants' invention is a large hand held external device that could not be employed inside a blood vessel. Therefore, pursuant to 37 C.F.R. § 1.144 the Applicants respectfully request the Examiner to reconsider the restriction requirement.

Claim Objections

In Paragraph 2 on Page 2 of the September 3, 2004 Office Action, the Examiner noted that the word "of" in Claim 39 and in Claim 51 had been misspelled. In response the Applicants have corrected the spelling of the word "of" in Claim 39 and in Claim 51 as requested by the Examiner.

Allowable Subject Matter

In Paragraph 13 on Page 5 of the September 3, 2004 Office Action, the Examiner stated that Claims 10-21 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

35 U.S.C. § 102(b) Anticipation

On Pages 3-4 of the September 3, 2004 Office Action, the Examiner rejected Claim 1 and Claims 6-9 under 35 U.S.C. § 102 (b) as being anticipated by United States Patent No. 5,522,829 to *Michalos*. On Pages 4-5 of the September 3, 2004 Office Action, the Examiner rejected Claims 1-5 and Claims 31-61 under 35 U.S.C. § 102 (e) as being anticipated by United States Patent No. 6,328,747 to *Nun*. The Applicants respectfully traverse these rejections for the reasons set forth below.

It is axiomatic that a prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *See, In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986) (citing with approval, *Lindemann Maschinenfabrik v. American Hoist and Derrick*, 221 USPQ 481, 485 (Fed. Cir. 1984)); *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 USPQ 619, 621 (Fed. Cir. 1985).

With respect to Claim 1 and Claims 6-9, a determination of anticipation in accordance with Section 102 requires that each feature claimed therein be described in sufficient detail in *Michalos* to enable one of ordinary skill in the art to make and practice the claimed invention. Similarly, with respect to Claims 1-5 and Claims 31-61, a determination of anticipation in accordance with Section 102 requires that each feature claimed therein be described in sufficient detail in *Nun* to enable one of ordinary skill in the art to make and practice the claimed invention.

The Applicants respectfully disagree with the Examiner's assertions regarding the subject matter disclosed in the *Michalos* reference and in the *Nun* reference. The Applicants respectfully submit that neither the *Michalos* reference nor the *Nun* reference shows each and every limitation of the Applicants' invention. The Applicants direct the Examiner's attention to Claim 1, which contains unique and novel limitations:

1. (Original) A surgical tool for making an incision in scleral tissue of an eye comprising:

a surgical blade capable of being moved by said surgical tool through said scleral tissue of said eye to make an incision having the form of a scleral pocket that is capable of receiving a scleral prosthesis. (Emphasis added).

The Examiner stated that "Regarding Claim 1, *Michalos* discloses a surgical tool with a blade (22) capable of cutting the sclera of the eye [Fig. 1]." (Paragraph 3, Page 3, September 3, 2004 Office Action). While *Michalos* discloses a surgical blade that is capable of cutting the scleral tissue of an eye, that is not sufficient to anticipate the Applicants' invention. This is because the surgical blade of *Michalos* is not capable of automatically making an incision that is in the form of a scleral pocket as taught by the Applicants' invention. The *Michalos* device comprises

a knife blade 48 for cutting out cataracts during eye surgery. The knife blade 48 may be rotated by a rack and pinion gear (44, 46) to adjust the angular orientation of knife blade 48. After the angular orientation of the knife blade 48 has been chosen, the knife blade 48 operates in a conventional manner.

The Specification of the patent application states that, “The system and method of the present invention comprises a surgical tool that is specifically designed to make very precise incisions in the sclera 102 of an eye 100 to form a scleral pocket 120.” (Specification, Page 28, Lines 7-10). The Applicants respectfully submit that there is nothing in the *Michalos* structure (including knife blade 48) that is capable of forming a scleral pocket in the scleral tissue of an eye by making a single incision. Therefore, Claim 1 and Claims 6-9 are not anticipated by the *Michalos* reference. The Applicants respectfully submit that Claim 1 and Claims 6-9 are all patentable over the cited prior art including the *Michalos* reference. The Applicants respectfully request that Claim 1 and Claims 6-9 be passed to issue.

The Examiner also stated that “Regarding Claims 1, 31, and 56, Nun discloses a surgical tool for making an incision in the eye and includes a surgical blade (246) [Fig. 18] capable of making an incision having the form of a pocket capable of receiving a prosthesis [Column 15, lines 61-63].” (Paragraph 7, Page 4, September 3, 2004 Office Action). “Nun discloses putting a prosthesis into the eye [Column 16, lines 6-8]. (Paragraph 7, Page 4, September 3, 2004 Office Action).

However, the prosthesis that *Nun* is referring to is an artificial lens that is placed in the eye after cataract surgery. The *Nun* prosthesis is not a scleral prosthesis. Although *Nun* discloses a

drill blade 246 that is capable of cutting the scleral tissue of an eye, that is not sufficient to anticipate the Applicants' invention. This is because the *Nun* drill blade 246 is not capable of automatically making an incision that is in the form of a scleral pocket as taught by the Applicants' invention. The Applicants respectfully submit that there is nothing in the *Nun* structure (including the *Nun* drill blade 246) that is capable is forming a scleral pocket in the scleral tissue of an eye by making a single incision. Therefore, Claims 1-5 and Claims 31-61 are not anticipated by the *Nun* reference.

The Applicants respectfully submit that Claims 1-5 and Claims 31-61 are all patentable over the cited prior art including the *Nun* reference. The Applicants respectfully request that Claims 1-5 and Claims 31-61 be passed to issue.

For the foregoing reasons, the Applicants respectfully request that Claims 1-21 and Claims 31-61 be passed to issue.

The Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicants reserve the right to submit further arguments in support of their above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

SUMMARY

For the reasons given above, the Applicants respectfully request reconsideration and allowance of pending claims and that this Application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at wmunck@davismunck.com. The Applicants hereby authorize the Commissioner to charge any necessary fees or credit any overpayments to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: Dec. 3, 2004

Docket Clerk
P.O. Drawer 800889
Dallas, Texas 75380
Tel: (972) 628-3600
Fax: (972) 628-3616
E-mail: wmunck@davismunck.com


William A. Munck
Registration No. 39,308